

## REMARKS/ARGUMENTS

Claims 1, 4-9, 11-14, 16, 17, 19-21, and 25 are pending in this application. Claims 2-3, 10, 15, 18, and 22-24 have been cancelled without prejudice.

### Claim Rejections- 35 U.S.C. § 112, paragraph 1 and 2

Appellants respectfully submit that the Examiner has impermissibly engaged in piecemeal examination of the instant application by raising §112, first and second paragraph rejections at this point in the prosecution of the instant application. Accordingly, the rejection is untenable and should be withdrawn.

The Examiner “ordinarily should reject each claim on all valid grounds available.” M.P.E.P. §707.07(g). Further, the Examiner’s action should be complete as to all matters. 37 C.F.R. 1.104 and M.P.E.P. §707.07(a).

Regarding Issue I, in the instant application, the Examiner issued a non-final Office Action dated January 4, 2005, which did not contain the §112, first and second paragraph rejections that are presently contained in the final Office Action dated September 8, 2005. Further, Applicant responded to the non-final Office Action by amending the claims to the form in which they currently exist in the application as of September 8, 2005. The Examiner then issued a final Office Action dated June 23, 2005, which did not contain the §112, first and second paragraph rejections that are contained in the final Office Action dated September 8, 2005. Applicant prepared and filed a Response to the final Office Action dated June 23, 2005 fully addressing all rejections made. From the Response to the final Office Action, the Examiner issued an additional final Office Action on September 8, 2005.

The September 8, 2005 Office Action is the third Office Action issued by the Examiner in the instant application, and for the first time raised the §112, first and second paragraph rejections. The §112, first paragraph rejection raises the issue of not satisfying

the written description requirement with respect to the claim language contained in Claims 1 through 25 of the instant application. Further, the §112, second paragraph rejection raises the issue of failing to particularly point out and distinctly claim the subject matter which Applicants regards as the invention with respect to Claims 1 and 25. It is respectfully submitted that the appropriate time in which to raise such a rejection is in the first office action in which such claim may be raised. The Examiner, by failing to make this rejection in the first office action in which such issue may have been raised (i.e. June 23, 2005), has engaged in impermissible piecemeal examination of the instant application, and has, by way of his own actions, established that Claims 1 through 25 satisfy the written description requirement under 35 U.S.C. § 112, first paragraph as well as the definiteness requirement under 35 U.S.C. § 112, second paragraph.

*Claim Rejections- 35 U.S.C. § 102*

The Patent Office rejected Claims 1, 9, 10-12, 14, 16-17, 19-21, and 25 under 35 U.S.C. § 102(a) as being anticipated by Fibre Channel Framing and Signaling working draft proposal, ("FC-FS Draft Standard," Rev. 1.30 published on July 9, 2001). Applicants respectfully traverse.

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *W.L. Gore & Assocs. v. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). If anticipation is based upon the inherent teaching of a prior art reference, the Examiner must provide a rationale or evidence tending to show inherency. As stated in *In re Robertson*, "to establish inherency the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be recognized by persons of ordinary skill." (emphasis added) *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Additionally, "inherency, however, may not be established by probabilities or possibilities." *Id.* Moreover, "the mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Id.*

The Patent Office, while rejecting Claims 1, 9 and 16, has particularly reviewed Claim 1. Claim 1, along with Claims 9 and 16, include elements that have not been taught, disclosed or suggested by FC-FS Draft Standard. For example, FC-FS Draft Standard fails to teach, disclose or suggest “the multi ported system includes more than two ports,” as recited in Claim 1. As stated in the Office Action, the diagram shown in the FC-FS-Draft (pages 532-533) only presents two ports. As correctly noted by the Examiner, the FC-FS Draft Standard discloses the use of two ports (FC-FS Draft Standard, pg 17, section 4.1) not more than two ports as claimed in the present invention. The Patent Office then asserts that the diagram could be inherently extended to cover all ports in the chain. Applicants respectfully disagree.

Applicants assert that “the multi ported system includes more than two ports” is not inherently present in the FC-FS Draft Standard. For instance, a typical fibre channel system is described by Wall (U.S. Patent 6,507,923) as including one or two ports. Wall et al., U.S. Patent 6,507,923, Background of the Invention. As stated previously, “the mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). In addition, the speed negotiation documented in the FC-FS Draft Standard does not converge deterministically in loop environments with more than two device nodes. Therefore, such embodiment is limited to two nodes and thus, is not useful in large drive loops consisting of numerous device nodes or ports. The present invention is beneficial for it provides a method of allowing speed negotiations on large loops (loops with more than two nodes) which the FC-FS Draft Standard lacks.

In addition, in regard to Claim 25, Applicants respectfully request that the Examiner clarify the rationale for rejecting such claim under 35 U.S.C. § 102(a) to allow Applicants to respond since it appears that portions of such rationale have been omitted from the Office Action. (Office Action page 6, number 24).

Accordingly, the rejection of Claim 1 should be withdrawn, and Claim 1 is allowable for the FC-FS Draft Standard fails to explicitly or implicitly teach, disclose, or suggest use of a multi-port system including more than two ports. Claims 9 and 16 are believed allowable for similar reasoning. Claims 10-12, 14, 17, 19-21 and 25 are believed to be allowable based on their dependence upon allowable base claims.

*Claim Rejections – 35 U.S.C. § 103*

The Patent Office rejected Claims 4, and 6-8 under 35 U.S.C. § 103(a) as being unpatentable over FC-FS Draft Standard. The Patent Office rejected Claim 5 under 35 U.S.C. § 103(a) as being unpatentable over FC-FS Draft Standard in view of Wall et al. (“Wall”, U.S. Patent No. 6,507,923). Claim 13 was rejected under 35 U.S.C. § 103(a) as being unpatentable over FC-FS Draft Standard in view of Mulvey et al. (“Mulvey”, U.S. Patent No. 6,629,219). Applicants respectfully traverse these rejections.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Ryoka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). *See also In re Wilson*, 165 U.S.P.Q. 494 (C.C.P.A. 1970).

Further, “to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” (emphasis added) (MPEP § 2143). If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. (emphasis added) *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

As indicated in the foregoing *Claim Rejections – 35 USC § 102* section, the primary reference, FC-FS Draft Standard fails to disclose, teach or suggest all the elements recited

in Claims 1, 9 and 16 including “the multi ported system includes more than two ports.” Applicants respectfully submit that any of the ancillary references (Wall and Mulvey) do not make up for the defects of FC-FS Draft Standard.

Wall is cited for the disclosure of use of a third channel in the system which the Patent office admitted that FC-FS Draft Standard does not explicitly disclose. Further, Mulvey is cited for the disclosure of a by-pass selector section which can by-pass disk drives, which the Patent office admitted that FC-FS Draft Standard does not explicitly disclose. However, neither Wall nor Mulvey cure the defect of FC-FS Draft Standard in reference to Claims 1, 9 and 16 for they do not explicitly or implicitly teach or suggest “the multi-ported system includes more than two ports” as recited in Claim 1.

Accordingly, Applicants respectfully request the removal of all the pending rejections under 35 U.S.C. §103 is respectfully requested and allowance is earnestly solicited.

### **CONCLUSION**

In light of the forgoing amendments and arguments, reconsideration of the claims is hereby requested, and a Notice of Allowance is earnestly solicited.

Respectfully submitted,

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